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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,665	08/07/2003	Hiraku Murayama	1029650-000144	8895

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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER

HOEKSTRA, JEFFREY GERDEN

ART UNIT	PAPER NUMBER
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3736

NOTIFICATION DATE	DELIVERY MODE
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08/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/635,665

Applicant(s)

MURAYAMA ET AL.

Examiner

JEFFREY G. HOEKSTRA

Art Unit

3736

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant argues the final rejection of claims 1, 24, and 28 under 35 U.S.C. 103(a) over Palermo in view of Reynolds mailed 05/18/2009.

Applicant argues neither Palermo nor Reynolds, taken alone or in combination, discloses, teaches, and/or fairly suggests a guidewire having coaxially disposed proximal and distal tips of first and second wires wherein the proximal and distal end faces of the first and second wires are welded.

More specifically applicant argues that "the disclosures in Palermo and Reynolds considered as whole does not support the rejection" and the rejection is based upon impermissible hindsight because one of ordinary skill in the art would not look to the guidewire of Reynolds to remedy the deficiencies of the "ribbon" of Palermo because one of ordinary skill in the art would not equate the structures relied upon in the rejection and that such a modified guidewire to one of ordinary skill in the art would have weakened the connection between the first and second wires.

The Examiner disagrees, maintains the rejection, and in response notes the following:

In response to applicant's argument that "the disclosures in Palermo and Reynolds considered as whole does not support the rejection", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case as broadly as structurally claimed and absent any special definition in the instant Specification upon which Applicant does not appear to be relying, one of ordinary skill in the art would recognize both Palermo and Reynolds disclose and teach multi-section composite guidewires and portions thereof comprised of multiple joined wire and/or ribbon portions mechanically secured to each other in order to configure the composite guidewire to traverse tortuous vasculature. The Examiner further notes that the "ribbon" as disclosed by Palermo is a strip of metallic material structurally comprising a "wire" (Palermo, column 6 lines 38-47). A "wire" may be plainly defined as "a slender, stringlike piece or filament of relatively rigid or flexible metal, usually circular in section, manufactured in a great variety of diameters and metals depending on its application". It is well known in the medical guidewire art that wires of different materials and/or shapes may be substituted for others in addition to the mechanical securement therebetween to construct and configure a composite guidewire to traverse tortuous vasculature. Consistent therewith and as set forth in the final rejection, "the claimed invention would have been obvious because the substitution of one known wire joining configuration for another known wire joining configuration would have yielded the predictable results of welding two guidewire components together to one of ordinary skill in the art at the time of the invention. Because both Palermo and Reynolds teach joining methods for components of guidewires, it would have been obvious to one skilled in the art at the time of the invention to substitute one joining method for the other to achieve the predictable results of securely welding two adjacent wire components of a composite guidewire to configure a guidewire to traverse tortuous vasculature".

In response to applicant's argument that "that such a modified guidewire to one of ordinary skill in the art would have weakened the connection between the first and second wires", the Examiner notes that a statement or argument by applicant's attorney is not factual evidence. See MPEP 716.01.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).